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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,819	09/23/2003	David A. Price	PC25377A	7016

28940 7590 11/15/2004

AGOURON PHARMACEUTICALS, INC.
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EXAMINER

SOLOLA, TAOFIQ A.

ART UNIT PAPER NUMBER

1626

DATE MAILED: 11/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/669,819	Applicant(s) PRICE ET AL.	
	Examiner Taofiq A. Solola	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-16 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-3, 10 and 12 is/are allowed.
- 6) ☐ Claim(s) 4-9, 11, 13-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1</u> . | 6) <input type="checkbox"/> Other: ____ |

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Claims 1-16 are pending in this application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 4-9, 11, 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4, 6 and 8 improperly depend from claim 1, claims 5, 7 and 9 improperly depend from claim 2 or 3 for failure to limit the scope of their independent claims. The dependent claims recite intended use of the their respective independent claims. Under US patent practice intended use is not a limitation of a product or compound. *In re Hack*, 114 USPQ 161 (CCPA, 1957); *In re Craig*, 90 USPQ 33 (CCPA, 1951); *In re Benner*, 82 USPQ 49 (CCPA, 1949). Therefore, claims 4, 6 and 8 are duplicates of claim 1; 5, 7 and 9 are duplicates of 2 or 3. By deleting the duplicates the rejection would be overcome.

Claims 11 is a substantial duplicate of claim 10, and claim 13 is a substantial duplicate of claim 12. For compounds of claims 10 and 12 to be used for inhibiting ^{or} treating HIV they necessarily must be used in form of a composition. By deleting "2 or" from claims 11 and 13 the rejection would be overcome.

Claim 14 is drawn to the same subject matter of claim 12 and claim 15 is drawn to the same subject matter of 13. Therefore, 14 and 15 are duplicates of 12 and 13 respectively. Under US patent practice duplicate claims or substantial duplicate claims cannot be in the same application. By deleting claims 14 and 15 the rejection would be overcome.

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Claim 16 is written in functional language and therefore, broader than the enabling disclosure. For example, the claim recites "preparing", "interconverting", "deprotecting" and "converting" in steps (C)-(E). The claim must recite how one of ordinary skill in the art would perform the "preparing", "interconverting", "deprotecting" and "converting". The claims must recite the reagents, the reaction times, pH, and reaction conditions that are involve in the steps. Also, the structure of the products of steps (A)-(B) must be shown in the claim. Applicant may not claim all applicable processes of "preparing", "interconverting", "deprotecting" and "converting" in the instant invention, known and yet to be developed. Applicant must claim only the processes that embody applicant's invention.

A claim must stand alone to define the inventions, and incorporation into the claims by reference to the specification or an external source is not permitted. Ex parte Fressola, 27 USPQ 2d 1608, BdPatApp & Inter. (1993). In patent examination, it is essential for claims to be precise, clear, correct, and unambiguous. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989).

Allowable Subject Matter

Claims 1-3, 10 and 12 are allowable over prior arts of record.

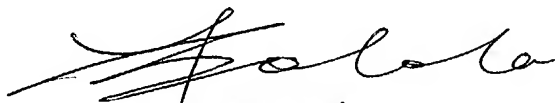
Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD, J.D. whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

A handwritten signature in black ink, appearing to read 'Solola', with a stylized flourish at the end.

TAOFIQ SOLOLA
PRIMARY EXAMINER

Group 1626

November 10, 2004